



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,412	07/21/2003	Donte Kim	58255-00005	7256

7590 11/18/2005
Sung I. Oh, Esq.
Squire, Sanders & Dempsey, L.L.P.
14th Floor
801 S. Figueroa Street
Los Angeles, CA 90017

EXAMINER

VIDWAN, JASJIT S

ART UNIT	PAPER NUMBER
----------	--------------

2182

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/624,412	Applicant(s) KIM ET AL.	
	Examiner Jasjit S. Vidwan	Art Unit 2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/09/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 5 and 15 are objected to because of the following informalities:
 - Claim 5, Line 2 recites 'the data includes credit card information, electronic check, electronic cash **and** electronic fund.' It's unclear to the examiner as to how the user is able to transmit data for all the above electronic payments at any one given time. It is Examiner's recommendation that the claim language be changed to read '...the data includes credit card information, electronic check, electronic cash **or** electronic fund.' For the purpose of the examination, the Examiner will limit the claim to either/or any of the above stated payment options.
 - The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 16-21 been renumbered 15-20.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the examiner as to what the applicant is attempting to claim in addition with failing to understand as to how a data could be transmitted to a package. For the purpose of application examination, the Examiner will limit the claim to: "The method according to claim 6, further including, combining the credit card information associated with the credit card transaction to a package.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 3, 4, 5, 18, 19, 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Fung et al, US Patent Application Pub. No: US 2005/0131815
[hereinafter "Fung"].

6. As per claim 1, Fung teaches a method [Abstract, Line 1] for interfacing data between first software [Fig. 26, element 2602, 'Merchant Terminal'] and the second

software [Fig 26, element 2612, '*Merchant Financial Institution*'] to process a transaction [Paragraph 0012, Lines 14-20, "*wherein the financial institution only accepts and processes charge request received from e-commerce websites...*"] between the first software and the second software, the method comprising:

- (i) Determining the data needed for processing a transaction from the second software by the first software [Paragraph 0067, Lines 4-5, *the Examiner construes Fung's teachings in the following manner: The "corresponding form data" that is retrieved by the first software (Merchant central website) from the second software (e-commerce Web site) determines the necessary data (form fields) that will be required to process the said transaction.*]
- (ii) Requesting the data from a client [Paragraph 0067, Lines 5-8]; and
- (iii) Processing the transaction using the data [Paragraph 0067, Lines 8-10].

7. **As per claim 2**, Fung teaches a method for making an electronic payment [Paragraph 0003, '*e-commerce*'], comprising:

- (i) Requesting the data from a client [Fig 6, element 608, '*update File*' containing *user information/data*],
- (ii) Retrieving the data from the client [Paragraph 0071, Lines 3-6]
- (iii) Processing the data through the payment processor to make the electronic payment [Paragraph 0071, Lines 1-3].

8. **As per claim 3**, wherein the data includes required information [Paragraph 0005, Line 5-9, '*credit/debit card information*'] and optional information [Paragraph 0005, '*optional demographic*'].

9. **As per claim 4**, wherein the client is a web-based client [Fig. 10, element 1014, *'Online Merchant'*].

10. **As per claim 5**, wherein the data includes credit card information [Paragraph 0005, Lines 5-9], electronic check, electronic cash or electronic fund.

11. **As per claim 18**, Fung teaches a system for interfacing a first software [Fig. 26, element 2602, *'Merchant Terminal'*] with a second software [Fig 26, element 2612, *'Merchant Financial Institution'*] to process a transaction between the first and second software [Paragraph 0012, Lines 14-20, "*wherein the financial institution only accepts and processes charge request received from e-commerce websites...*"], the system comprising:

(i) A memory storing first required and optional input parameters [Page 3, Paragraph 0044, Line 17-20, "*stored at the central web site location*"] to process the transaction through first software;

(ii) A server capable of communicating with the memory [Page 3, Paragraph 0045, Line 9-10] to determine the first required and optional input parameters and acquiring from the second software the first required and optional input parameters [Page 3, Paragraph 0045, Line 12-16, the Examiner construe the teaching as follow: *Since the server has access to the internet and communicates with the plurality of web sites, it has access to both the user data and the required/optional information needed by the said web site*], if any, to process the transaction from the second software to the first software.

12. **As per claim 19**, wherein Fung discloses a system where the memory stores second required and optional input parameters [Page 3, Paragraph 0045, Col. 2, Line 2-6, the Examiner interprets the teaching as follow: *The form manager servlet determines the required/optional information requested by the second software (Merchant Financial Institution) and determines whether more information is needed from the user in form of 'multiple forms' to complete the required/optional information from the second software*] to process the transaction through the second software, the server acquires from the first software the second required and optional input parameters [Page 3, paragraph 0046, the Examiner interprets Fung's teaching as follow: *after the information has been cataloged, the user is presented with additional information that was requested by the second software and requested to fill in appropriately that do not match the template fields of central web site*], if any, to process the transaction from the first software to the second software.

13. **As per claim 20**, Fung teaches a system for interfacing a first software [Fig. 26, element 2602, '*Merchant Terminal*'] with a second software [Fig 26, element 2612, '*Merchant Financial Institution*'] to process a transaction between the first and second software [Paragraph 0012, Lines 14-20, "*wherein the financial institution only accepts and processes charge request received from e-commerce websites...*"], the system comprising:

(i) A memory storing first required and optional input parameters to process a first transaction at the first software [page 2, Paragraph 0041, 15-17, the Examiner interprets the teaching as follow: the central user account management stores the user's data into

its template forms and processes the information as provided by the user at the central website (first software)] and storing second required and optional input field parameters to process a second transaction at the second software [Page 3, Paragraph 0045, Col. 2, Lines 2-16, the Examiner construes Fung's teaching as follow: After the central website's form manager servlet recognizes the exact additional information that is needed by the second software, it allows the user to enter the appropriate information and the provided information is processed at the appropriate website (second software)]; and

(ii) A server capable of communicating with the memory to determine the first and second required and optional input parameters [Page 3, Paragraph 0045, Line 12-16, the Examiner construe the teaching as follow: *Since the server has access to the internet and communicates with the plurality of web sites, it has access to both the user data and the required/optional information needed by the said web site*] and acquiring the first required and optional input parameters from the second software [Page 3, Paragraph 0045, Col. 2, Lines 2-6] and providing the first required and optional input parameters to the first software to process the first transaction [Paragraph 0045, Col. 2, Lines 6-10], the server further capable of acquiring the second required and optional input parameters from the first software and providing the second required and optional input parameters to the second software to process the second transaction [Paragraph 0046, Lines 6-11].

14. Claims 6, 7, 11, 13, 14, 15, 16, are rejected under 35 U.S.C. 102(b) as being anticipated by Haff et al, US Patent Application Pub. No: US 2005/0049515 [*hereinafter "Haff"*].

15. **As per claim 6**, Haff discloses a method for interfacing merchant's credit card with a plurality of payment processors [Page 18, Paragraph 0196, '*multiple credit processors*'], the method comprising:

(i) Determining the payment processor to be used [Page 18, Paragraph 0196, "*...selects the system (credit processor) to contact randomly*"] from the plurality of payment processors [Page 18, Paragraph 0196, '*multiple credit processors*'] for a credit card transaction.

(ii) Retrieving the data needed to process the credit card transaction through the payment processor [Page 17, Paragraph 0184, "*...and is subsequently prompted for appropriate account information.*"];

(iii) Requesting the data from a client to process the credit card transaction through the payment processor [Page 17, Paragraph 0184, Col.2, Line 4-6, "*The number of credits being requested is also collected*"]

(iv) Processing the data through the payment processor to process the credit card transaction [Paragraph 0185, Lines 1-5].

16. **As per claim 7**, Haff teaches a method where the data includes both required [Page 17, Paragraph 0184, Col. 2, Line 6-9, '*credit card number or an account number*'] and

optional data [Page 17, Paragraph 0184, Col.2, Line 13-19, '*IP address or telephone number*'].

17. As per claim 11, Haff also discloses a method wherein the merchant's credit card processing system is a web-based merchant [Page 1, Field of Invention, "*transferring computer files electronically from one location to another...*"].

18. As per claim 13, Haff discloses a template with input fields to the merchant's credit card processing system for the requesting of the data [Page 17, Paragraph 0184, '*prompted for appropriate account information*'].

19. As per claim 14, Haff discloses a method providing a template with input fields for the required data [Page 17, Paragraph 0184, "*The number of credits being requested is also collected, either automatically or through user prompts,*" the Examiner construes Haff's disclosure as follow: The number of credits for which to charge the customer is required information as the credit processor would not be able to process the credit card transaction without correctly being aware of the exact amount to charge] and optional data [Page 17, Paragraph 0184, "*IP address or telephone number*", the Examiner interprets the teaching as follow: The term 'Preferably' leads the examiner to believe that the above stated information is not required and would only be preferred] to the merchant's credit card processing system for requesting the data.

20. As per claim 15, Haff discloses a method for interfacing a merchant's payment processor system to a plurality of payment processors [Page 18, Paragraph 0196] each

having a plurality of input fields [Page 17, Paragraph 0184, "...prompted for appropriate account information"] for completing a transaction, the method comprises:

(i) Determining the payment processor corresponding to the transaction from the plurality of payment processors [Page 18, Paragraph 0196, "...selects the system (credit processor) to contact randomly."]

(ii) Determining whether each of the input fields for the payment processor is a required input field [Page 17, Paragraph 0184, Col. 2, Line 6-9, 'credit card number or an account number'] or an optional input field [Page 17, Paragraph 0184, Col.2, Line 13-19, 'IP address or telephone number'] to process the transaction, and

(iii) Requesting the method and optional input fields, if any, from a client through the merchant's payment processing system to process the transaction [Page 17, Paragraph 0184, 'Preferably the accounting information and the number of credits requested along with the sending PC's identity authentication and IP address or telephone number...']

21. As per claim 16, Haff discloses a method for processing a payment transaction between a merchant's payment processing system and a plurality of payment processors [Page 18, Paragraph 0196] each having a plurality of input fields to process a transaction, the method comprising:

(i) Updating the plurality of input fields for each of the plurality of payment processors to process the transaction [Page 17, Paragraph 0184, "If the information has been entered previously, an opportunity is provided to edit the information before sending it."]; and

(ii) Determining whether each of the input fields for plurality of payment processors is a required input field or an optional input field [Page 18, Paragraph 0184]

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haff and further in light of Gangi, US Patent No 6,938,821 (*hereinafter Gangi*).

24. **As per claim 8**, Haff teaches a system for interfacing a plurality of merchant's payment processing systems with a plurality of payment processors [Page 18, Paragraph 0196] each having a plurality of input fields to process a plurality of payment transactions between the plurality of merchant's payment processing systems and the payment processors.

Haff fails to disclose a method wherein reducing the credit card transaction fee if the merchant provides the optional data. However, Gangi discloses a method to where incentives are provided for providing personal optional information [Claims 14].

One of ordinary skill in the art at the time of applicant's invention would have clearly recognized that it is quite advantageous to have incentives or coupons for users that provide additional personal information, which would be helpful for advertising, and

marketing coupons for future purchases. It is for this reason that one of ordinary skill in the art would have been motivated to use Gangi's disclosure in light of Haff to provide coupons, incentives or discounts to customers for providing optional information.

25. Claims 9, 10, 12, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haff et al. U.S. Patent Application Publication 2004/0049515 (*hereinafter Haff*) as applied to claim 6 further in light of Fung et al. U.S. Patent Application Publication 2005/0131815 (*hereinafter Fung*).

26. **As per claim 9**, Haff discloses a method for interfacing merchant's credit card with a plurality of payment processors [Page 18, Paragraph 0196, '*multiple credit processors*'] and retrieving the credit/debit card data required to process the transaction from the client [Page 17, Paragraph 0184, "...and is subsequently prompted for *appropriate account information*."]. Additionally, Haff discloses a method where in the said data also includes both required data and optional data [Page 17, Paragraph 0184].

Haff fails to teach a method to store the credit card transaction into a memory. However, Fung discloses a system and method to store credit card transaction into memory [Page 11, Paragraph 0114].

One of ordinary skill in the art at the time of applicant's invention would have clearly recognized that it is quite advantageous for credit card transactions be stored into memory. It is for this reason that one of ordinary skill in the art would have been

motivated to enhance Haff's invention with Fung's disclosed embodiment because it would be valuable to store the transaction information for future credit card processing.

27. **As per claim 10**, Haff discloses a method for interfacing merchant's credit card with a plurality of payment processors [Page 18, Paragraph 0196, '*multiple credit processors*'] and retrieving the credit/debit card data required to process the transaction from the client [Page 17, Paragraph 0184, "...and is subsequently prompted for *appropriate account information*."]. Additionally, Haff discloses a method where in the said data also includes both required data and optional data [Page 17, Paragraph 0184].

Haff fails to teach a method for inserting the credit card information associated with the credit card transaction to a package. However, Fung discloses such a method to insert all the information gathered from the user into a package [Fig.1, element 122].

One of ordinary skill in the art at the time of applicant's invention would have clearly recognized that it is quite advantageous for credit card information be stored into a package for transmitting for information security purposes. It is for this reason that one of ordinary skill in the art would have been motivated to use Fung's disclosed embodiment in conjunction with Haff et al to keep all information in a package prior to transmitting the confidential information between the first and second software [See Haff, Paragraph 0185, Line 9-10].

28. As per claim 12, Haff discloses a method for interfacing merchant's credit card with a plurality of payment processors [Page 18, Paragraph 0196, '*multiple credit processors*'] and retrieving the credit/debit card data required to process the transaction from the client [Page 17, Paragraph 0184, "...*and is subsequently prompted for appropriate account information.*"]. Additionally, Haff discloses a method where in the said data also includes both required data and optional data [Page 17, Paragraph 0184].

Haff fails to disclose a method where the merchant's credit card processing system is a point-of-sale merchant. However, Fung discloses a point-of-sale merchant [Summary of Invention, Paragraph 012, Line 1-5, "destination ecommerce web site"].

One of ordinary skill in the art at the time of applicant's invention would have clearly recognized that it is quite obvious that a merchant can also be point-of-sale merchant. It is for this reason that one of ordinary skill in the art would have been motivated to further claim a point-of-sale merchant as an entity that could use the said invention [Page 19, Paragraph 0199].

29. As per claim 17, Haff teaches a system for interfacing a plurality of merchant's payment processing systems with a plurality of payment processors [Page 18, Paragraph 0196] each having a plurality of input fields to process a plurality of payment transactions between the plurality of merchant's payment processing systems and the payment processors.

Haff fails to disclose a method wherein a memory storing the plurality of input for a predetermined number of payment processors, where the plurality of input fields includes required and optional input field. Furthermore, Haff fails to teach a method wherein a server is capable of requesting from a merchant's payment processing system a payment processor to use to process a payment transaction and retrieving from the memory the required and optional input fields corresponding to the payment processor. However, Fung teaches a method of storing the plurality of input for a predetermined number of payment processors, where the plurality of input fields include required and optional input field [Paragraph 0042, Line 1-4]. Furthermore, Fung teaches a method wherein a server is capable of requesting from a merchant's payment processing system a payment processor to use to process a payment transaction retrieving from the memory the required and optional input fields corresponding to the payment processor [Page 3, Paragraph 0045, Line 12-16, the Examiner construe the teaching as follow: *Since the server has access to the internet and communicates with the plurality of web sites, it has access to both the user data and the required/optional information needed by the said web site*].

One of ordinary skill in the art at the time of applicant's invention would have clearly recognized that it is quite advantageous to have a server that would be able to access not only the information already input by the user, but also additional information that might be needed by a specific processor. It is for this reason that one of ordinary skill in the art would have been motivated to use Fung's invention in addition to Haff to

form a server which would communicate between the first software and the second software [Background of the Invention, Paragraph 0006, Line 5-14]

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasjit S. Vidwan whose telephone number is (571) 272-7936. The examiner can normally be reached on 8am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KIM HUYNH can be reached on (571) 272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JV
11/9/2005



KIM HUYNH
PRIMARY EXAMINER

11/14/05